

REMARKS

In an Office Action, the Examiner: (1) rejected claims 1-3, 6-8, 12-19, 23-28, 32-37, and 41 under 35 U.S.C. § 102(e) as being anticipated by O'Neil et al. (U.S. Pat. No. 5,987,440) (O'Neil); (2) rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over O'Neil; (3) rejected claims 9-11, 20-22, 29-31, 38-40, and 43-44 under 35 U.S.C. § 103(a) as being unpatentable over O'Neil in view of Ando et al. (U.S. Pat. App. Pub. No. 2001/0018706) (Ando); and (4) rejected claim 42 under 35 U.S.C. § 103(a) as being unpatentable over O'Neil in view of Goldhaber et al. (U.S. Pat. No. 5,855,008) (Goldhaber).

Applicants' representatives thank Examiners Igor Borrisov and John Weiss for the Interview on August 14, 2003. At the Interview, Applicants proposed amendments relating to offering an incentive to potential users to induce potential users to contribute consumer information to a database of consumer information (see claims 1, 14, 23, and 32), and amendments relating to a declining fee schedule that decreases licensing fees paid to a user until detection of a predetermined user event (claims 89 and 92).

Applicants have also amended claims to clarify the access preferences received from the users. No new matter has been added. Specifically, exemplary support for offering the incentives to potential users can be found in the specification at page 9, lines 17-20, page 10, lines 1-15, and FIG. 3. Further, exemplary support for the declining fee schedule can be found in the specification at page 17, lines 7-14. Finally, exemplary support for the amended subject matter related to the access preferences can be found in the specification at page 13, line 4-page 14, line 4.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

In sum, this Amendment amends claims 1-3, 6, 8, 12-14, 16-19, 23, 25-28, 30-32, 34-37, and 42-44, and cancels claim 41 without prejudice or disclaimer of the subject matter thereof. Applicants have also added new claims 45-92. Applicants submit that independent claims 1, 14, 23, 32, and 42-44 are patentably distinguishable from O'Neil, taken alone or in consideration with the other cited references, for the reasons below.

1. Rejection of Claims 1-3, 6-8, 12-19, 23-28, and 32-37
Under 35 U.S.C. § 102(e)

Claim 1, as amended, is allowable because O'Neil does not teach, among other things, "at least one database containing personal information provided by at least one user in response to an incentive offered to at least one user to contribute the personal information to the database." Similarly, claims 14, 23, and 32 each recite a combination, including, for example, "offering an incentive to potential users to induce the potential users to contribute consumer information for a database of personal information.

As explained at the interview with the Examiner, O'Neil is directed to a website based electronic community, labeled as the "E-Metro" community. (col. 2, lines 2-33). Among other security mechanisms for the members of this "E-Metro" community, O'Neil teaches release of information related to the community members based on certain rules. (col. 16, lines 36-63). However, nothing in O'Neil discloses or suggests providing an incentive to induce community members to become part of the "E-Metro" community. O'Neil, therefore, does not disclose or suggest offering an incentive to potential users to induce them to contribute consumer information for storage in a database accessible

by subscribers, as recited in claims 1, 14, 23, and 32. For at least the above reasons, claims 1, 14, 23, and 32 are patentably distinguishable from O'Neil.

Claims 2-3, 6-8, 12-13, 15-19, 24-28, 33-37, 45-88 depend, either directly or indirectly, from one of independent claims 1, 14, 23 and 32, and are therefore allowable at least because they depend from a patentable claim.

2. Rejection of Claims 9-11, 20-22, 29-31, 38-40, and 43-44
Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9, 20, 29, 38, 43, and 44 under § 103 as being unpatentable over O'Neil and Ando. Each of these claims recite a "declining fee schedule." Similarly, newly added claims 89 and 92 recite "declining fee schedule such that a licensing fee paid to a user declines until detection of a predetermined user event." Neither O'Neil or Ando, alone or in combination teaches a licensing fee schedule that is a "declining fee schedule," as required by each of these claims.

Ando, in contrast, is directed towards providing increased benefits to users. Ando describes giving a discount for use of an electronic mail service to a user A who forwards an advertisement to a user B, and further giving a discount to the user B if the user B "refers" to that advertisement. (paragraphs 0009 and 0010). The paragraphs that the Examiner cites to from Ando discuss vaguely the discounting of electronic mail service by noting that an "information apparatus can be realized which can increase, or decrease the use fee charged to the information provider based upon the additional information." (Paragraph 0039). In other words, Ando simply teaches discounting of electronic mail use, where a user forwards an advertisement with an electronic mail message and where another user "refers" to that advertisement. This discounting

program of Ando has nothing to do with providing a licensing fee schedule personal information contributed by a user, let alone a declining fee schedule for personal information, as required by claims 9, 20, 29, 38, 43, 44, 89, and 92. Thus, even if Ando could be combined with O'Neil, claims 9, 20, 29, 38, 43, 44, 89, and 92 are allowable for this additional reason.

Moreover, the Examiner suggests that it would have been obvious to modify O'Neil in view of Ando to include the declining fee schedule because "it would allow a third party to advertise their products or services for a fee, thereby making the system more profitable." April 23, 2003, Office Action, page 5, paragraph 1. Applicants respectfully submit that the evidence cited by the Examiner would not motivate one of ordinary skill in the art to modify O'Neil to include the claimed declining fee schedule. At most, Ando would only suggest modifying O'Neil to provide discounts to members of the E-Metro community for electronic mail usage when they forward an advertisement to another member of the E-Metro community and when the other member refers to the forwarded advertisement. In this regard, however, O'Neil does not even teach charging members of the E-Metro community for electronic mail use, thus it is not clear how or why one would want to combine Ando with O'Neil. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness. Thus, claims 9, 20, 29, 38, 43, 44, 89, and 92 are allowable for this additional reason.

Claims 10, 11, 21, 22, 30, 31, 39, 40, 90, and 91, 93, and 94 depend, directly or indirectly, from one of claims 9, 20, 29, 38, and 89, and are therefore allowable at least because they depend from a patentable claim.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

3. Rejection of Claim 42 Under 35 U.S.C. § 103(a)

Claim 42 is allowable for at least two reasons. First, the Examiner has failed to establish a prima facie case of obviousness by not providing any evidence of a motivation or a suggestion to combine O'Neil and Goldhaber in the manner suggested by the Examiner. Specifically, the Examiner states that it would have been obvious to modify O'Neil in view of Goldhaber because this would allow "subscribers to attract attention of users to their advertisements, thereby mak[ing] the system more attractive to the customers." April 23, 2003, Office Action, page 5, paragraph 5. Applicants respectfully note that the above does not provide any evidence of a suggestion or motivation to modify O'Neil such that it would include each of the elements of claim 42. This is because attracting attention of users to advertisements has no relationship with, and thus would not suggest, "paying each user based on a set of payment rules, wherein one of the set of payment rules includes paying the user for purchasing a product or service from one of the subscribers," as recited in claim 42. Accordingly, Applicants respectfully submit that claim 42 is allowable over the cited references.

Second, Applicants respectfully note that even if Goldhaber could be combined with O'Neil, any proper combination would not include "paying [a] user for purchasing a product or service from one of the subscribers." Goldhaber is directed towards paying a customer for viewing "negatively priced information," such as an advertisement. (col. 10, lines 39-57). Viewing an advertisement is not the same as purchasing a product or service. At most, Goldhaber would simply suggest paying a user for viewing an advertisement. Thus, Goldhaber does not teach or suggest "paying [a] user for

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

purchasing a product or service from one of the subscribers," as recited in claim 42.

Claim 42 is therefore allowable over the cited references for this additional reason.

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 25, 2003

By: 

Ranjeev K. Singh
Reg. No. 47,093

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER ^{LLP}

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com